

respectfully submits, in response, that the amendments for claim form above are in substantial accord with the Examiner's suggested rewordings, and remove all of the grounds for objections. Applicant therefore respectfully requests that the objects be withdrawn. More particularly,

Claim 11 is canceled without prejudice or disclaimer;

Claim 12, at line 15 (line 9 of the examined claim 12), after "said plurality", "or" is changed to "of";

Claim 13, at line 9, after "oriented generally", "long" is changed to "along";

Claim 14, at line 10 (line 8 of the examined claim 14), after "team members", "aid" is changed to "said"; and

Claim 15, at line 2, after "comprising", the period "." is changed to a colon ":".

All of the above amendments are for matters of form, do not necessitate further examination of the claims, and require cursory review by the Examiner to identify that they are responsive to the objections. Applicant therefore respectfully request entry of the above-identified amendments, and withdrawal of the stated objections.

III. Rejections Under 35 U.S.C. § 112, first paragraph.

The Final Office Action sets forth rejections of claims 11-15 under 35 U.S.C. § 112, first paragraph, on the grounds that, in the examined form, each recited language which, in the opinion of the Examiner,

constituted subject matter not adequately described by the specification as to meet the requirements of Section 112. See Final Office Action at paragraph no. 4.

To expedite examination Applicant has canceled claim 11, and has amended the form of each of claims 12-15. Applicant submits that the amendments place the claims into better form, and remove all language the Office Action identifies in its rejection under Section 112, first paragraph. Applicant respectfully submits that each of the amended claims 12-15 is fully supported by the original specification and drawings, within the requirements of 35 U.S.C. § 112, first paragraph. Applicant further submits that the above amendments for claim form require only cursory review by the Examiner to identify their being responsive to these rejections, and do not necessitate any additional search by the Examiner. Applicant therefore respectfully urges that the amendments be entered and that the rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

IV. Rejections Under 35 U.S.C. § 112, second paragraph.

The Final Office Action sets forth rejections of claims 11 and 13 under 35 U.S.C. § 112, second paragraph, on grounds enumerated as (1) and (2), respectively, by the Examiner. See Final Office Action at paragraph no. 5.

Claim 11 is canceled, which renders the rejection moot.

Claim 13 is amended at line 8 to insert "wireless" after "integrated", as suggested by the Examiner.

Applicant respectfully submits that claim 13 as amended for form is in condition for allowance, including meeting the definiteness requirements under 35 U.S.C. § 112, second paragraph, and therefore respectfully urges withdrawal of this rejection.

V. The Rejection of Claims 1-3, 5, 7-9 and 20-22 as Unpatentable Under 35 U.S.C. § 103 over Camras in view of Takahashi.

The Office Action rejects claims 1-3, 5, 7-9 and 20-22 as unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 3,984,625 ("Camras") in view of U.S. Patent No. 5,305,033 ("Takahashi"). See Office Action at paragraph nos. 6-7, pages 4-7.

Applicant respectfully submits, in response, that the Office Action has misconstrued Camras and Takahashi, and that the combined disclosures of these references fail to establish *prima facie* obviousness of any pending claim of the instant application, including claims 1-3, 5, 7-9 and 20-22.

A. The Law and the Evidentiary Standards Governing USPTO Determination Of Patentability of a Claim.

The standards governing the examination of claims for patentability under 35 U.S.C. § 103 are set forth in the Manual of Patent Examination and Procedure ("MPEP") and, for convenience, relevant provisions will be summarized.

To establish *prima facie* obviousness of a claim under 35 U.S.C. § 103, the Examiner must show an

objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art contains (1) all of the limitations of the claim, (2) a teaching or suggestion that would lead that individual to combine and modify those elements into the claimed combination, and (3) a reasonable expectation that the claimed combination would be a success. MPEP § 2142, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). [other citations omitted]

For examination purposes in determining if the prior art discloses, teaches or suggests a claim limitation, the wording of the limitation is given its broadest reasonable meaning that is not inconsistent with the specification. *In re Graves*, 69 F.3d 1147 (Fed. Cir. 1995).

B. The Combination of Camras and Takahashi Lacks the Claim 1 Feature and Structure of the Video Camera, or Imager, Receiving or Capturing Images Concurrent With Operation of the Flashlight Beam.

The Office Action explicitly admits that Camras, the primary reference relied for the rejection, "does not particularly disclose... [a] light source for selectively emitting a beam of light, wherein the beam of light is capable of remaining on during the operation of the image." Office Action at page 6.

The Office Action then asserts Takahashi to be a qualifying secondary reference that, according to the Office Action, can be combined with Camras and thus

render Applicant's claims 1-3, 5, 7-9 and 20-22 obvious under 35 U.S.C. § 103. Office Action at pages 6-7.

Applicant respectfully submits that the Office Action incorrectly relies on Takahashi as a reference for modifying Camras because, in fact, Takahashi teaches (at best) the exact opposite of what it is cited for.

Takakashi discloses a combination still camera/flashlight. Takahashi's disclosure teaches - in fact dictates - that the flashlight is and must be OFF when the camera obtains an image. See Takahashi at column 3, lines 46 through 64; and column 4, lines 55 through 61. In fact, the only structure that Takahashi discloses with respect to operating the flashlight and camera shutter automatically turns the flashlight OFF when the camera shutter opens. *Id.* Takahashi does not teach, and suggests nothing of, any structure for, or function of, holding the shutter open when the flashlight beam is on. In fact, the only suggestion that Takahashi contains regarding such a structure is simply to not have it; Takahashi teaches that having the shutter open (hence obtaining an image) while the flashlight is on would wash out the picture, hence destroying the disclosed purpose of Takahashi's apparatus. See Takahashi at column 4, lines 61 through 68.

Under PTO examination standards, and the law governing same, in order for the combination of Camras and Takahashi to render base claim 1 obvious, that combination must, at least, teach or suggest all of the claim 1 limitations. See MPEP § 2142. If Camras and

Takahashi were to have such a disclosure, which they do not, *prima facie* obviousness further requires, either in those references or in another objective teaching, (and there is none shown), a teaching or suggestion for combining and/or modifying their respective disclosures into the claimed combination. MPEP § 2142.

The combination of Camras and Takahashi fails to meet even the first requirement for establishing *prima facie* obviousness. The combination fails because, *inter alia*, nowhere within their aggregate disclosures is any teaching or suggestion to be found of a structure for, or function of, concurrent operation of an image and a flashlight beam, much less a suggestion of such a structure sufficient to meet the requirements for establishing *prima facie* obviousness.

Applicant submits that for this reason alone the combination of Camras and Takahashi cannot establish *prima facie* obviousness of Applicant's base claim 1.

Claims 2-3, 5, 7-9 and 20-22 are dependent on claim 1, and are therefore patentable over the combination of Camras and Takahashi for at least the reasons Applicant has shown for claim 1. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

C. Camras and Takahashi Lack Any Suggestion or Motivation for Combining or Modifying their Respective Disclosures to Have the Claim 1 Combination of the Video Camera, or Imager, Receiving or Capturing Images Concurrent With Operation of the Flashlight Beam.

Camras and Takahashi lack not only the first requirement for establishing *prima facie* obviousness, namely, a teaching or suggestion of all of the claim limitations, their combined disclosures fail the second requirement for establishing *prima facie* obviousness, namely, they lack a teaching or suggestion for combining and/or modifying their respective disclosures into the claim 1 combination. See MPEP § 2142.

MPEP 2143.01 states that "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION". Applicant is at a loss, however, with respect to identifying how the Office Action found Camras and Takahashi, particularly in view of Takahashi's teaching of shutting off the flashlight beam when the camera shutter opens, as suggesting the desirability of Applicant's claim 1. The only teaching or suggestion found anywhere in the combination of Camras and Takahashi concerning a flashlight beam and an imager is found in Takahashi. The total of Takahashi's disclosure on this feature is the following: emphasis of a structure automatically turning the flashlight beam OFF when the camera shutter is open.

Applicant submits, therefore, that upon reading Takahashi in its entirety one of ordinary skill in the art would conclude that claim 1's structure is ill-advised. Applicant therefore respectfully submits that

Camras and Takahashi cannot show a suggestion to modify and combine their respective disclosures, or any other prior art, to achieve Applicant's claim 1.

MPEP 2143.01 also states that "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE".

According to Takahashi, however, operating the flashlight beam concurrent with its disclosed camera shutter being open will wash out the picture. See Takahashi at column 4, lines 55 through 68.

Takakashi discloses a combination still camera/flashlight. Takahashi's disclosure teaches - in fact dictates - that the flashlight is and must be OFF when the camera obtains an image. See Takahashi at column 3, lines 46 through 64; and column 4, lines 55 through 68. Therefore, based on the teachings of Camras and Takahashi, the proposed modification of Camras that the Office Action asserts Takahashi to suggest would, in fact, render both of them unsatisfactory for their intended purpose.

For the further reasons above, the combination of Camras and Takahashi fails to establish *prima facie* obviousness of Applicant's base claim 1.

Claims 2-3, 5, 7-9 and 20-22 are dependent on claim 1, and are therefore patentable over the combination of Camras and Takahashi for at least these additional reasons Applicant has shown for claim 1. See *In re Fine*, 837 F.2d 1071, *supra*.

VI. The Rejection of Claims 10, 18 and 19 as Unpatentable Under 35 U.S.C. § 103 Over the Combination of Camras and Takahashi, in View of Walling.

The Office Action rejects claims 10, 18 and 19 and 20-22 as unpatentable under 35 U.S.C. § 103 over the combination of Camras and Takahashi, in view of U.S. Patent No. 4,802,008 ("Walling"). See Office Action at paragraph no. 8, pages 7-9.

Claims 10, 18 and 19 each depend ultimately from claim 1. Applicant submits for reasons presented at Section V of this Response, *supra*, that base claim 1 is patentable over the combination of Camras and Takahashi. Claims 10, 18 and 19 are therefore patentable over Camras and Takahashi. See *In re Fine, supra*.

Therefore, for the combination of Camras, Takahashi and Walling to render dependent claims 10, 18 and 19 obvious, the Office Action must, as a threshold requirement, show that Walling, when combined with Camras and Takahashi, renders base claim 1 obvious. Walling fails to meet this requirement. Walling fails because, among other reasons, it teaches nothing of the operation of a flashlight and a camera of any kind, and certainly nothing of a concurrent operation of the light beam and imager.

Applicant respectfully submits for the above reasons that Walling suggests zero as to modifying or otherwise motivating one ordinary skill in the art to rearrange, redesign and/or reconstruct the combined disclosures of Camras and Takahashi in any manner toward Applicant's base claim 1. Applicant therefore

respectfully submits that, for at least this reason, the combination of Camras, Takahashi and Walling cannot render any of Claims 10, 18 and 19 obvious under 35 U.S.C. § 103.

VII. The Rejection of Claims 11-13 and 15 as Unpatentable Under 35 U.S.C. § 103 Over the Combination of Camras and Takahashi, in View of Saitoh.

The Office Action rejects claims 11-13 and 15 as unpatentable under 35 U.S.C. § 103 over the combination of Camras and Takahashi, in further view of U.S. Patent No. 4,777,526 ("Saitoh"). See Office Action at paragraph no. 9, pages 9-10.

Claim 11 is canceled without prejudice or disclaimer, for purposes of expediting the examination with respect to rejections under 35 U.S.C. § 112.

Claims 12 and 13 each recite, among other limitations, detection and broadcast of an image concurrent with generation of a flashlight beam. See claim 12 at lines 11-13, and claim 13 at lines 12-14.

Applicant respectfully incorporates and realleges, as if set forth here in its entirety, the showing under Section V of this Response, *supra*, that the combination of Camras and Takahashi fails to teach or suggest a device having an integrated imager and flashlight wherein the image is obtained concurrent with generation of the flashlight beam.

Applicant therefore respectfully submits that for at least the reasons shown under Section V, *supra*, the combination of Camras and Takahashi fail to render

either of claims 12 and 13 obvious. Saitoh adds nothing to the combination of Camras and Takahashi. Saitoh is not a reference with respect to any device, much less an integrated imager and flashlight, wherein the image is obtained concurrent with generation of the flashlight beam.

The combination of Camras, Takahashi and Saitoh therefore fails to meet even one of the three requirements for establishing *prima facie* obviousness of claims 12 and 13, namely, (i) a teaching or suggestion of all of the claims' limitations, (ii) a suggestion or motivation to combine and/or modify their respective disclosures into the claimed combination, and (iii) a showing of a reasonable expectation of success. See MPEP § 2143.

VIII. The Rejection of Claims 14 as Unpatentable Under 35 U.S.C. § 103 Over the Combination of Camras, Takahashi, and Saitoh in Further View of Walling.

The Office Action rejects claim 14 as unpatentable under 35 U.S.C. § 103 over the combination of Camras, Takahashi, and Saitoh, in further view of Walling. See Office Action at paragraph no. 10, pages 10-12.

Claims 14 depends from claim 13. Applicant submits for reasons presented at Section V and VII of this Response, *supra*, that base claim 13 is patentable over the combination of Camras, Takahashi and Saitoh. Claim 14 is therefore, at least on this basis alone, patentable over Camras, Takahashi and Saitoh. See *In re Fine, supra*.

Therefore, for the combination of Camras, Takahashi, Saitoh and Walling to render dependent claim 14 obvious, the Office Action must, as a threshold, at least show that Walling, when combined with the other three reference, renders base claim 13 obvious.

Walling fails to meet this requirement. Walling fails because, among other reasons, it teaches nothing of the operation of a flashlight and a camera of any kind, and certainly nothing of a concurrent operation of the light beam and imager.

Applicant therefore respectfully submits that the combination of Camras, Takahashi, Saitoh and Walling cannot render dependant claim 14 obvious under 35 U.S.C. § 103.

IX. The Rejection of Claim 16 as Unpatentable Under 35 U.S.C. § 103 Over the Combination of Camras, and Takahashi, in Further View of Teetzel.

The Office Action rejects claim 16 as unpatentable under 35 U.S.C. § 103 over the combination of Camras, and Takahashi, in further view of U.S. Patent No. 5,548,137 ("Teetzel"). See Office Action at paragraph no. 11, pages 12-13.

Claims 16 depends from claim 1. Applicant submits for reasons presented at Section V of this Response, *supra*, that base claim 1 is patentable over the combination of Camras and Takahashi. Claim 16, for at least this reason alone, is patentable over Camras and Takahashi. See *In re Fine, supra*. Therefore, for the combination of Camras, Takahashi, and Teetzel to render dependent claim 16 obvious, the Office Action must, as a

threshold requirement, show that Teetzel, when combined with Camras and Takahashi, renders base claim 1 obvious.

Teetzel fails to meet this requirement. Teetzel shows, at best, an arrangement of a flashlight and a laser pointer. Teetzel does not disclose or suggest anything of an imager, or of combining its features with an imager, and suggests nothing regarding a concurrent operation of a flashlight beam and imager.

Applicant therefore respectfully submits that the combination of Camras, Takahashi, and Teetzel cannot render dependant claim 16 obvious under 35 U.S.C. § 103.

X. The Rejection of Claim 17 as Unpatentable Under 35 U.S.C. § 103 Over the Combination of Camras and Takahashi, in Further View of Stanuch.

The Office Action rejects claim 17 as unpatentable under 35 U.S.C. § 103 over the combination of Camras, and Takahashi, in further view of U.S. Patent No. 5,097,397 ("Stanuch"). See Office Action at paragraph no. 12, page 13.

Claims 17 depends from claim 1. Applicant submits for reasons presented at Section VI of this Response, *supra*, that base claim 1 is patentable over the combination of Camras and Takahashi. Claim 17, for at least this reason alone, is patentable over Camras and Takahashi. See *In re Fine, supra*. Therefore, for the combination of Camras, Takahashi, and Stanuch to render dependent claim 17 obvious, the Office Action must, as a threshold requirement, show that Stanuch, when combined with Camras and Takahashi, renders base claim 1 obvious.

Stanuch fails to meet this requirement. Stanuch shows RF shielding. Applicant does not claim RF shielding as an invention. Applicant claims RF shielding combined with the combination of claim 1. Stanuch does not teach or suggest Applicant's claim 1. The combination of Camras and Takahashi fail to suggest Applicant's claim 1. The combination of Camras, Takahashi and Stanuch fails to suggest Applicant's claim 1 because, among other reasons, these combined references do not disclose or suggest anything of a concurrent operation of a flashlight beam and imager.

Applicant therefore respectfully submits that the combination of Camras, Takahashi, and Stanuch cannot render dependant claim 17 obvious under 35 U.S.C. § 103.

XI. The Office Action Has Misconstrued the Prior Art With Respect to Claim 21 Because Neither Takahashi Nor Any Other Item of the Cited Art Disclose a Rod-Like Light Source, as Recited by that Claim.

Applicant's claim 21 recites the "security system of claim 1 wherein the handheld light source has a rod-like shape." No item of the cited prior art has any disclosure, teaching or suggestion of this limitation.

The words "rod-like shape" must be interpreted as broadly as is reasonable and consistent with the specification. See, e.g., *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). A dictionary is a proper source for determining what that meaning is. See, e.g., *In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002) (Citing IBM Dictionary of Computing and Van Nostrand Reinhold Dictionary of Information

Technology 473 as authority for broadest reasonable meaning of claim terms.) See also *In re Maxwell*, 856 F.2d 201 (Fed. Cir. 1988) (Citing Webster's II New Riverside Dictionary to show broadest reasonable meaning of "graph" included "chart").

Applicant therefore references Merriam Webster's Collegiate Dictionary, Third Edition, for the broadest reasonable meaning of "rod-like". The word "rod", in the context of describing the shape of an object, is defined by the cited Merriam Webster's dictionary as "a slender bar (as of wood or metal)" See Exhibit A attached hereto. Referencing the same Merriam Webster's Collegiate Dictionary, the word "bar", again in the context of describing the shape of an object, means

1 a : a straight piece (as of wood or metal) that is longer than it is wide and has any of various uses (as for a lever, support, barrier, or fastening b : a solid piece or block of material that is usu[ally] considerably longer than it is wide.

Merriam Webster's Collegiate Dictionary, Third Edition, quoted portion attached as Exhibit B.

The Office Action states that Takahashi's Fig. 1 shows a "rod-like shape handheld light source." Office Action at page 6. Applicant respectfully submits that the Office Action has erred, because the statement is not supported by the Takahashi disclosure. The flashlight 1 shown by Takahashi's Fig. 1 is not within the broadest reasonable meaning of "rod-like". Nowhere in the Takahashi reference is there any suggestion for a "rod-like handheld light source." In view of the

lateral displacement between the Takahashi's lens shutter 22, and reflector 10 surrounding the light bulb 12, a "rod-like handheld light source" is completely outside of the scope of structures than one of ordinary skill in the art would find suggested by Takahashi.

The rod-like shape recited by claim 21 is functional. The Examiner can take Official Notice that law enforcement personnel regularly carry flashlights having a rod-like shape, as it attaches more easily to a belt, is more easily carried and pointed than a flashlight shape as disclosed by, and as dictated by the operation disclosed by Takahashi. Also, as stated by Applicant's specification, the claim 21 recited shape functions as a weapon when necessary, much more readily than the shape disclosed by Takahashi.

Applicant respectfully requests for the further reasons presented above that the rejection of claim 21 be withdrawn.

XII. The Office Action Has Misconstrued the Prior Art With Respect to Claim 22 Because Neither Takahashi Nor Any Other Item of the Cited Art Disclose or Suggest a Collinear Imager and Flashlight Beam.

Applicant's dependent claim 22 recites the flashlight beam being collinear with the imager axis. No item of the cited art teaches, discloses or suggests anything of this limitation.

According to Merriam Webster's Collegiate Dictionary, Third Edition, the word "collinear", in the context recited in Applicant's claim 22, means "lying on

or passing through the same straight line." See Exhibit C.

None of the cited prior art, taken alone, or viewed in combination with any other item, discloses this limitation.

The closest prior art to Applicant's base claim 1 is Takahashi. Takahashi shows a flashlight bulb 12 and a camera shutter 22. The axis of Takahashi's flashlight beam is defined by the reflector 10, in which the bulb 12 is centered.

Applicant respectfully submits that there is no structure, function or operation taught or suggested anywhere within Takahashi, or any other item of cited prior art, that is, or can operate as, a flashlight beam and an imager having respective optical axes arranged to be within the broadest reasonable meaning of "collinear".

Applicant therefore submits that Takahashi, standing alone or combined with any other grouping of cited prior art, cannot render Applicant's claim 22 obvious.

XIII. Conclusion.

Applicant respectfully submits that all pending claims of the present application stand in condition for allowance.

The Examiner is respectfully requested to contact the undersigned, at the telephone number below, if any further action or changes are deemed necessary to expedite this case.

Reply Under 37 C.F.R. § 1.116
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Please charge any deficiencies in fees and credit
any overpayment of fees to Attorney's Deposit Account
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